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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,100	07/30/2003	Philip E. Eggers	NET 2-098	8307

7590

08/09/2005

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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

88

<b>Office Action Summary</b>	<b>Application No.</b> 10/630,100	<b>Applicant(s)</b> EGGERS, PHILIP E.	
	<b>Examiner</b> Michael Peffley	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 23-27, 29-39, 41, 50-52 and 56-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-21, 40, 42-48 and 54 is/are rejected.
- 7) ☒ Claim(s) 22, 28, 49, 52 and 55 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/20/04; 5/31/05</u> | 6) <input type="checkbox"/> Other: _____  |

***Election/Restriction***

Applicant's response, received May 17, 2005 has been fully considered by the examiner. In particular, applicant has elected the invention of Group II, claims 16-69 with traverse. Additionally, applicant has elected the embodiment of Species I, Figures 1-3, and indicated that claims 16-22, 28, 40, 42-49 and 53-55 read on the elected species.

With regard to the traversal, applicant contends that Section 121 of the Patent Statute authorizes a requirement for restriction only when two or more independent and distinct invention are claimed in one application. The examiner agrees with this assertion; however, the examiner maintains that the itemized inventions and species are independent and distinct and the restriction requirement is therefore proper.

It appears applicant has taken issue to the language used in the form paragraphs delineating the restriction. The form paragraphs do not explicitly state that the inventions are "independent and distinct". Rather, the language only makes use of the term "distinct". The examiner maintains that the use of these form paragraphs are standard throughout the Office and they are deemed to be represent the intention that the examiner maintains that the inventions are independent and distinct. That the two inventions (i.e. the method and the apparatus) may be related to one another in operation or effect does not preclude them from being independent and distinct. As asserted in the original Election/Restriction, the method is capable of an entirely different use such as the treatment of skin tissue or uterine tissue. It is noted that numerous patents in any given subclass of the US Patent Classification System are

“related in operation or effect”, yet that does not mean that these inventions are not “independent and distinct”. The examiner maintains the restriction as set forth in the January 21, 2005 Office action is proper, and the restriction is maintained.

With regard to the Election of Species, applicant has traversed this issue as well, but has not provided any particular reason for the traversal. Applicant contends that Figure 4 is another view of the apparatus of Figure 1, and that Figure 5 is a cross-section of Figure 4. The examiner agrees with this assertion and the species of Embodiment 1 is now deemed to be Figures 1-5. The examiner also agrees that claim 16 is a generic claim and will be considered as such.

The following is a complete action on claims 16-22, 28, 40, 42-49 and 53-55 with claims 1-15, 23-27, 29-39, 41, 50-52 and 56-69 being withdrawn from further consideration as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-21, 40, 42-48 and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Hooven (5,814,044).

Hooven discloses a device for cutting and removing tissue comprising a cannula assembly (22) having an outer surface, an electrosurgical cutting assembly (Figure 6A, elements 68,69; Figure 6B, elements 70,71) mounted at the cannula distal region and

Art Unit: 3739

delivering RF energy to tissue thereby heating tissue/fluid in the vicinity of the electrodes. There is also an intake port (62) at the distal end of the cannula, the intake port connected to a transfer channel (24) extending along the length of the cannula assembly to an evacuation outlet in the handle assembly of the device. It is noted that there is an air gap (see, for example, Figure 6b) between the outer cannula (22) and the evacuation channel (24), the gap inherently acting as a heat transfer isolation mechanism. The inner and outer tubes may be made from a variety of materials, including thermally insulative plastics or metals coated with insulative plastics (see column 5, line 40 through col. 6, line 30). It is noted that various electrode shapes are disclosed, including substantially cylindrical electrodes (Figures 6a, 6d and 6f), the electrode assembly being rotatable with the inner shaft to cut tissue.

#### ***Allowable Subject Matter***

Claims 22, 28, 49, 53 and 55 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

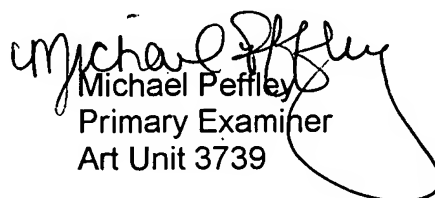
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Considine et al (5,718,709), Burbank et al (6,331,166), Ritchart et al (5,810,806), Eggers et al (6,514,248) and Bales et al (4,682,596) disclose various RF cutters for removing tissue through an endoscopic device.

Art Unit: 3739

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Michael Peffley  
Primary Examiner  
Art Unit 3739

mp  
August 8, 2005